

### **REMARKS**

Claims 1-2 and 10-35 are pending. Claims 1 and 12 were amended as discussed below. New claims 16-31 were amended to further define preferred embodiments of the present invention.

No “new matter” was added in this amendment.

Regarding amended claims 1 and 12, the added phrase, “the marginal region...having no content image portion” is clearly supported by at least Figs. 2A and 3A, and their corresponding description. For example, in Figs. 2A and 3A, the content image portion 30 does not appear anywhere on the sheet of paper, and thus inherently does not appear in the marginal region.

Furthermore, the new phrase is fully compliant with the guidelines set forth in MPEP 2173.05(i) regarding “negative limitations,” attached hereto as Appendix A, because the boundaries of patent protection being sought are set forth definitely, albeit negatively, and the negative limitation has a basis in the original disclosure as discussed above.

Regarding new independent claims 16 and 20 and new dependent claims 32 and 33, these claims are identical to the previous version of claims 1 and 12, except for the new phrase, that the blank region and the marginal region are “adjacent to each other on only one side of their respective regions.” This new phrase, is also clearly supported by at least Fig. 2A, and its corresponding description. In Fig. 2A, regardless of where the dividing line exists between the two regions, the two regions share only one adjacent edge.

Regarding new independent claims 24 and 28 and dependent claims 34 and 35, these claims are identical to the previous version of claims 1 and 12, except for the new phrase that the marginal region includes “only color bar-related indicia.” This new phrase, is also clearly supported by at least Figs. 2A and 3A, and their corresponding description. For example, Fig. 2A shows a color bar and the text, “magSend Color bar.” Both of these items constitute only color bar-related indicia. Figs. 3A shows a color bar which inherently constitutes only color bar-related indicia.

### **Request for Interview Prior to Formal Action on Amendment**

Applicant requests an interview prior to formal action on this response. An “Applicant Initiated Interview Request Form” accompanies this response. Please contact Applicant’s undersigned representative to schedule the interview.

### **Prior Art Rejection**

Claims 1, 2 and 10-15 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Chalmers et al. (hereafter, “Chalmers”). Applicant respectfully traverses this rejection as it pertains to the amended claims and the new claims.

#### **1. New rationale for rejection**

In the outstanding rejection, the Examiner now identifies different regions in Fig. 1 of Chalmers than were identified in the previous rejection as allegedly meeting the claimed regions. See the marked up version of Fig. 1 on page 5 of the May 1, 2008 rejection compared to the marked-up version of Fig. 1 on page 7 of the outstanding rejection. This new interpretation of Chalmers still does not meet the previously presented version of claims 1 and 12. However, to advance prosecution of the application, claims 1 and 12 were further amended to even more clearly patentably distinguish over the Examiner’s latest interpretation of Chalmers.

#### **2. § 102 vs. § 101 rejection**

Throughout the Office Action, the Examiner improperly mixes issues that relate to patentability under § 102 with issues that relate to patentability under § 101. Even if the Examiner believes that the color bars are “printed matter,” it is improper to ignore claim limitations. “Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter.” *In re Gulack*, 703 F. 2d 1381, 1385 (Fed. Cir. 1983). “The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior

art...The PTO may not disregard claim limitations comprised of printed matter.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994), citing *Gulack*.

While Applicant believes that both rejections are improper, there is no reason to maintain the § 102 rejection even if the § 101 rejection is not withdrawn, particularly in the present situation where the § 102 rejection has been clearly overcome.

3. Patentability of amended independent claims 1 and 12 over Chalmers

Amended claims 1 and 12 read as follows (underlining added for emphasis):

1. An article of manufacture for use in a proofing process comprising a sheet of paper that includes:

(a) a blank region for subsequent printing of a content image portion; and

(b) a marginal region outside of the blank region, the marginal region including one or more standard color bars pre-printed thereon and having no content image portion, and each of the one or more standard color bars having a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space, wherein the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper.

12. An article of manufacture for use in a proofing process comprising a sheet of paper that includes:

(a) a marginal region including one or more standard color bars pre-printed thereon and having no content image portion, and each of the one or more standard color bars having a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space; and

(b) a blank region outside of the marginal region for subsequent printing of a content image portion, wherein the marginal region and the blank region constitute the entire surface area of one side of the sheet of paper.

Chalmers does not disclose at least the above-identified feature of claims 1 and 12.

On page 7 of the outstanding Office Action, the Examiner shows a marked-up version of Fig. 1 of Chalmers that identifies a “blank region” bordered by a dotted line, and states that the “marginal region” is the area outside of the dotted line (i.e., the area outside of the blank region).

Referring to amended claims 1 and 12, the marginal region as identified by the Examiner in Chalmers includes content image portions, namely, images 2 (illustrations of color prints 2),

whereas in the claimed invention, no content image portions appear in the marginal region. Thus, since Chalmers does not disclose each and every element of amended claims 1 and 12, withdrawal of the § 102(b) anticipation rejection is respectfully requested.

Nor does Chalmers suggest the invention recited in amended claims 1 and 12. The areas of the master chart sheet of Chalmers that includes the images 2 cannot be ignored because these claims recite that “the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper.” If the areas of the images 2 were ignored, then the blank region and the marginal region identified by the Examiner would not constitute the entire surface area of one side of a sheet of paper (i.e., Chalmers’ master chart sheet). Nor would it have been obvious to delete the images 2 from the master chart sheet because that would destroy the intended manner of operation of Chalmers’ invention, which is to juxtapose images 2 next to picture representations 2A of the Fig. 2 test sheet in the combined printed sheet shown in Fig. 3 of Chalmers to assist in calibrating a printing engine.

Applicant’s invention has a completely different purpose than Chalmers, namely to be used in a proofing process. In Applicant’s invention, there is no reason to print a content image portion in the marginal region that includes one or more standard color bars pre-printed thereon. In fact, in preferred embodiments of the present invention shown in Figs. 2A and 3A, the content image portion is not printed anywhere on the sheet of paper. This feature is clearly reflected in amended claims 1 and 12 which recites a marginal region<sup>1</sup> that has no content image portion, a blank region (i.e., devoid of writing, images or marks<sup>2</sup>), and the feature that the “the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper.” This combination of features is neither disclosed nor suggested by Chalmers.

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<sup>1</sup> Applicant is claiming a marginal region using the ordinary dictionary definition of “marginal,” namely, “of, relating to, located at, or constituting a margin, a border, or an edge” (marginal. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/marginal> (accessed: September 12, 2008)). Furthermore, this ordinary dictionary definition is consistent with Applicant’s disclosure which clearly shows a marginal region in Fig. 2A and 3A that is located at a margin or edge of the proofing paper.

<sup>2</sup> blank. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/blank> (accessed: September 12, 2008).

4. Patentability of new independent claims 16 and 20 over Chalmers

New claims 16 and 20 read as follows (underlining added for emphasis):

16. An article of manufacture for use in a proofing process comprising a sheet of paper that includes:

(a) a blank region for subsequent printing of a content image portion; and

(b) a marginal region outside of the blank region, the blank region and the marginal region being adjacent to each other on only one side of their respective regions, the marginal region including one or more standard color bars pre-printed thereon, and each of the one or more standard color bars having a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space, wherein the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper.

20. An article of manufacture for use in a proofing process comprising a sheet of paper that includes:

(a) a marginal region including one or more standard color bars pre-printed thereon, and each of the one or more standard color bars having a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space; and

(b) a blank region outside of the marginal region for subsequent printing of a content image portion, the blank region and the marginal region being adjacent to each other on only one side of their respective regions, wherein the marginal region and the blank region constitute the entire surface area of one side of the sheet of paper.

Chalmers does not disclose at least the above-identified feature of claims 16 and 20.

As discussed above, one preferred embodiment of the above-highlighted feature is shown in Fig. 2A, and its corresponding description. In Fig. 2A, regardless of where the dividing line exists between the two regions, the two regions share only one adjacent edge, and thus the blank region and the marginal region are inherently adjacent to each other on only one side of their respective regions.

In contrast to the present invention, the blank region and the marginal region identified by the Examiner in Chalmers are adjacent to each other on at least three sides (left, top and right). Accordingly, claims 16 and 20 are believed to be novel over Chalmers.

Nor would it have been obvious to rearrange the blank region identified by the Examiner so that it is adjacent to the marginal region on only one side. As discussed in previous responses, the purpose of Chalmers' sheets has nothing whatsoever to do with the purpose of the claimed sheet. Fig. 1 of Chalmers is not designed to be used in a proofing process. Thus, there would be no reason to rearrange the blank region identified by the Examiner so that it is adjacent to the marginal region on only one side, thereby rendering it more suitable for use in a proofing process, other than to meet the claimed invention. Such a rearrangement of the blank region would constitute improper hindsight reconstruction of Applicant's invention using Applicant's claims as a guide.

5. Patentability of new independent claims 24 and 28 over Chalmers

New claims 24 and 28 read as follows (underlining added for emphasis):

24. An article of manufacture for use in a proofing process comprising a sheet of paper that includes:

(a) a blank region for subsequent printing of a content image portion; and

(b) a marginal region outside of the blank region, the marginal region including one or more standard color bars pre-printed thereon and only color bar-related indicia, and each of the one or more standard color bars having a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space, wherein the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper.

28. An article of manufacture for use in a proofing process comprising a sheet of paper that includes:

(a) a marginal region including one or more standard color bars pre-printed thereon and only color bar-related indicia, and each of the one or more standard color bars having a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space; and

(b) a blank region outside of the marginal region for subsequent printing of a content image portion, wherein the marginal region and the blank region constitute the entire surface area of one side of the sheet of paper.

Chalmers does not disclose at least the above-identified feature of claims 24 and 28.

As discussed above, one preferred embodiment of the above-highlighted feature is shown in Figs. 2A and 3A, and its corresponding description. For example, Fig. 2A shows a color bar and the text, "magSend Color bar." Both of these items constitute only color bar-related indicia. Figs. 3A shows a color bar which inherently constitutes only color bar-related indicia.

In contrast to the present invention, the marginal region identified by the Examiner in Chalmers does not include only color bar-related indicia. For example, the marginal region includes images 2. Accordingly, claims 24 and 28 are believed to be novel over Chalmers.

Nor would it have been obvious to include only color bar-related indicia in the marginal region identified by the Examiner in Chalmers. This would involve deleting the images 2 from the master chart sheet of Chalmers. Deleting the images 2 would destroy the intended manner of operation of Chalmers' invention, which is to juxtapose images 2 next to picture representations 2A of the Fig. 2 test sheet in the combined printed sheet shown in Fig. 3 of Chalmers to assist in calibrating a printing engine.

#### 6. Patentability of dependent claims 10, 14, 18, 22, 26 and 30 over Chalmers

Dependent claim 10 reads as follows:

10. The article of manufacture of claim 1 wherein the marginal region of the sheet of paper is a minor region of the sheet of paper and the blank region is a major region of the sheet of paper.

This feature is not disclosed in Chalmers. In fact, the regions identified by the Examiner as being equivalent to the claimed marginal region and blank region are exactly opposite of the claimed relationship. In Chalmers, the marginal region of the master chart sheet is a major region of the sheet of paper and the blank region is a minor region of the master chart sheet. Applicant respectfully traverses the Examiner's arguments in support of this rejection.

First, the Examiner argues that this feature does not need to be given any patentable weight because there is "no novel functional relationship of the printed material to the substrate." This is clearly erroneous. It is an important structural feature of the sheet of paper that the marginal region be a minor region of the sheet of paper and that the blank region be a major region of the sheet of paper. The blank region is used for subsequent printing of the content image portion, such as a proof as shown in Fig. 2B. To effectively review a proof, the image to

be proofed should be as large as possible on the proofing paper. That is, it should cover a major region of the proofing paper. In contrast, the color bars need not be large in size to effectively perform their function so they need only cover a minor region of the proofing paper.

Furthermore, even if the Examiner believes that the color bars are “printed matter,” it is improper to ignore such limitations. “Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter.” *In re Gulack*, 703 F. 2d 1381, 1385 (Fed. Cir. 1983). “The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art...The PTO may not disregard claim limitations comprised of printed matter.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994), citing *Gulack*.

Lastly, as argued below in the response to the §101 rejection, the requisite functional relationship of the printed material to the substrate clearly exists in the present invention, and thus the alleged lack of such a relationship cannot be used to ignore a clearly recited structural feature. See the discussion of *In re Miller* in the paragraph numbered 5b.

Second, the Examiner states that it is “user judgment to consider the blank region as being a major region of importance and the marginal region as being a minor region of importance” (underlining added for emphasis). In response, Applicant does not claim any priority of importance between the two regions. Applicant is claiming a “major region” and a “minor region” using the ordinary dictionary definition of the words “major” and “minor”, namely, “major” being “great in number, size, or extent<sup>3</sup>,” and “minor” being “lesser or smaller in amount, extent, or size.”<sup>4</sup> Furthermore, these ordinary dictionary definitions are consistent with Figs. 2A and 3A of Applicant’s disclosure which clearly shows the respectively claimed regions as being major and minor regions of the proofing paper. Stated simply, the claimed “blank region” must be met by a region that is great in number, size, or extent, and the claimed “marginal region” must be met by a region that is lesser or smaller in amount, extent, or size.

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<sup>3</sup> major. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/major> (accessed: September 12, 2008).

<sup>4</sup> minor. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/minor> (accessed: September 12, 2008).



The regions labeled by the Examiner as being the blank region and marginal region do not meet these definitions, and in fact, are opposite of such definitions.

Third, the Examiner argues that Applicant's drawings and specification do not "define the marginal region nor the blank region with any demarcations." Applicant respectfully traverses this argument. While the exact demarcations of the regions are not defined in the present invention, Fig. 2A in view of Fig. 2B, and Fig. 3A in view of Figs. 3B and 3C clearly illustrate that the marginal region of the sheets of paper in Figs. 2A and 3A is meant to be a minor region of the sheets of paper, and the blank region of the sheets of paper in Fig. 2A and 3A is meant to be a major region of the sheets of paper. Furthermore, it is well-known in the proofing art that the color bars usually take up only a small marginal area of a proof, whereas the content portion encompasses a relatively larger area of the proof. Thus, an artisan familiar with proofing processes, viewing Figs. 2A-3C, would clearly understand that the marginal region and blank region in Figs. 2A and 3A are defined by minor and major regions, respectively.

Dependent claims 14, 18, 22, 26 and 30 are believed to be patentable for the same reasons as applied to claim 10.

#### 7. Patentability of dependent claims 11, 15, 19, 23, 27 and 31 over Chalmers

Claim 11 is further believed to be patentable over Chalmers because the master chart sheet in Chalmers is not proofing paper. The process described in Chalmers was summarized in the Petition to Make Special filed in the parent Application No. 10/192,404. The discussion is repeated below for convenience.

U.S. Patent No. 5,953,990 (Chalmers et al.) discloses a process for calibrating color printing in a printing engine. The process uses a master sheet and a test sheet. The master sheet has a first array of desired colors thereon. The test sheet has a second array of the desired colors thereon. The second array is offset from the first array so that when the first and second arrays are aligned, each of the desired colors of the first array is immediately adjacent to the same desired color of the second array. A printing engine prints an image of the master sheet on the test sheet. Then, the colors of the printed image of the master sheet's first array that appear on the test sheet are compared with the corresponding desired colors of the test sheet's second array that are immediately adjacent thereto. The printing engine is then adjusted based on the

comparison. This process does not perform the combination of steps underlined above.

There is no use of a proof in Chalmers. The process in Chalmers is used to adjust a printing engine, not to determine if a proof is made that meets industry standards. Since there is no proof used or created in Chalmers, neither the master sheet nor the test sheet (with or without the master sheet image printed thereon) are proofing paper. Thus, no “proofing paper” is provided in Chalmers, as required by claim 11.

Stated simply, Fig. 1 of Chalmers merely shows a reference image that is to be printed as part of the calibration process. The reference image in Fig. 1 includes both color bars 1 and color pictures 2. Fig. 1 is not a sheet of proofing paper.

Notwithstanding these arguments, the Examiner provides the following rationale for supporting the rejection over Chalmers in the outstanding Office Action (underlining added for emphasis):

Chalmers et al disclose the article of manufacture of claim 1 wherein the sheet of paper is proofing paper (Examiner reads proofing paper as Chalmers paper used for visual inspection. A proof is known in the art to be a version of a document or color illustration produced specifically for the purpose of review prior to reproduction. A proof is also known in the art as a test sheet made to reveal errors or flaws, predict results on press and record how a printing job is intended to appear when finished. Chalmers et al. satisfy the claim.)

Applicant respectfully traverses this reasoning. The definitions given by the Examiner of a proof completely refute the argument that the master chart sheet in Chalmers is proofing paper. Regarding the Examiner’s first statement, “A proof is known in the art to be a version of a document or color illustration produced specifically for the purpose of review prior to reproduction,” the master chart sheet in Chalmers is used for making adjustments to a printing engine that will subsequently produce documents other than the master chart sheet. The master chart sheet itself is not being reproduced. Nobody in the printing arts would reasonably consider a master chart sheet for adjusting a printing engine like the one shown in Chalmers to be proofing paper because no proof is even generated in the Chalmers process. At best, Chalmers can be described as a process that occurs before a proof is generated using the printing engine

after it has been adjusted. Regarding the Examiner's second statement, "A proof is also known in the art as a test sheet made to reveal errors or flaws, predict results on press and record how a printing job is intended to appear when finished," no printing job related to the master chart sheet is finished in Chalmers. That is, the lady image 2 appears only in the master chart sheet, not in any subsequently run printing job.

Dependent claims 15, 19, 23, 27 and 31 are believed to be patentable for the same reasons as applied to claim 11.

#### 8. Patentability of remaining dependent claims over Chalmers

These dependent claims are believed to be patentable over Chalmers for at least the reason that they are dependent upon allowable base claims and because they recite additional patentable elements and steps.

Dependent claims 32 and 33 are further believed to be patentable over Chalmers for at least the same reasons as applied to independent claims 16 and 20, as discussed above.

Dependent claims 34 and 35 are further believed to be patentable over Chalmers for at least the same reasons as applied to independent claims 24 and 28, as discussed above.

#### 9. Applicant's comments regarding Examiner's "Response to Arguments"

Pages 3-5 of the outstanding Office Action presents various responses to Applicant's previous prior art arguments. However, since the manner in which Chalmers is being applied against the claims has been changed, these responses appear to be moot. Accordingly, except for one issue below, no rebuttal responses are provided.

In the paragraph spanning pages 3-4 of the outstanding Office Action, the Examiner argues that Applicant has failed to show where the marginal region and the blank region begins and ends. While the Examiner does not specify exactly which claims this argument is directed to<sup>5</sup>, Applicant repeats the following general rebuttal comments that were also presented on pages 5-6 of the Supplemental Remarks filed on October 29, 2008.

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<sup>5</sup> This argument appears to be relevant to at least dependent claims 10, 14, 18, 22, 26 and 30.

The Examiner's underlying issue is that Applicant has failed to define the boundaries of the regions (blank and marginal). This is simply not the case. Exemplary claim 1 clearly recites a marginal region (i.e., a region of, relating to, located at, or constituting a margin, a border, or an edge) and that the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper. Fig. 2A shows one preferred embodiment of claim 1 wherein one color bar appears at a top margin, and the remaining portion of the sheet of paper is blank. Absent the presence of any prior art that reads on the claims (and none that reads on the present set of claims has been applied to date), there is no necessity or requirement for Applicant to further limit the claims to any specific boundary, such as stating that the marginal region constitutes the top 5% of the surface area of the sheet of paper from edge to edge, and the blank region constitutes the remaining 95% of the surface area of the sheet of paper. As long as no prior art reads on the claims and that the claims accurately reflect at least one preferred embodiment shown in the figures (and both of these conditions are met), Applicant is entitled to claim the invention as currently presented.

### **35 U.S.C. § 101 rejection**

In the outstanding rejection, the Examiner repeated verbatim the § 101 rejection given in the Office Action dated May 1, 2008. Applicant traversed this rejection in the "Amendment After Final Rejection..." filed on September 16, 2008 and formally entered on October 29, 2008 in the subsequently filed Request for Continued Examination (RCE). However, since the Examiner did not respond to any of the arguments presented in the "Amendment After Final Rejection," such arguments are substantively repeated below for consideration by the Examiner. The arguments are equally pertinent to the amended claims and the newly filed claims.

1. The amended claims recite an article of manufacture for use in a proofing process which is one of the statutory categories of subject matter encompassed under 35 U.S.C. § 101.<sup>6</sup>

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<sup>6</sup> 35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The printed matter doctrine is a judicially-created doctrine that the USPTO has used to deny patentability to inventions directed to printed lines, characters, words, and digits that are contained on a medium and readable by humans. The presently claimed invention does not have any of these properties. While the claimed color bars are printed on the sheet of paper, they are not “printed matter” in that they are not meant to be read like one would read words, numbers or symbols to extract a meaning.

3. Each of the one or more claimed standard color bars have “a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space.” Applicant has thus clearly claimed structural features of the article of manufacture.

4. The claimed color bars are no different in nature than visual targets on an eye test chart apparatus. See, for example, U.S. Patent No. 7,357,508 (Suzuki), which claims an eye test chart apparatus comprising visual targets. The front page and claim 1 of Suzuki is attached hereto as Appendix B. Suzuki was rejected under 35 U.S.C. § 101 but was subsequently allowed after the claims were amended to recite an eye chart apparatus which was argued to be one of the statutory categories of subject matter encompassed under 35 U.S.C. § 101. Here, Applicant believes that an “article of manufacture” better characterizes the appropriate statutory category.

5. The Examiner asked Applicant to review MPEP 706.03(a) which reads as follows:

MPEP 706.03(a)

A. Printed Matter

For example, a mere arrangement of printed matter, though seemingly a “manufacture,” is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). (underlining in the Examiner’s Office Action)

Applicant traverses the relevance of this MPEP excerpt because the claimed invention is not a mere arrangement of printed matter and none of the cited case law supports such a conclusion. It is Applicant's understanding that the MPEP case law is the USPTO's attempt to define the types of issues that arise in "printed matter" rejections and to indicate the types of inventions that are and are not non-statutory under § 101.<sup>7</sup>

a. **In re Jones:** Applicant's claimed color bars are "structure" analogous to the pattern areas in *Jones*. *Jones* provides the following instructions on how to distinguish between non-statutory printed matter and printing on a surface (underlining added for emphasis):

That claim, and the others likewise, do not, in our opinion, define "printed matter" in the sense in which that term has heretofore been used to indicate various sorts of indicia whose primary purpose is the conveying of intelligence to a reader. What we find on the disk we would not characterize as indicia or printing but as structure, albeit the "pattern areas" of claim 1 are not necessarily transparent and opaque, respectively, and might be produced by some sort of printing technique. *In re Jones*, 153 USPQ 77 at 80-81 (underlining added for emphasis)

Certainly there is no "printing" in this case in the form of words or other symbols intended to convey intelligence to a reader nor in the form of rulings as on a business form. *Jones* at 81 (underlining added for emphasis)

Like *Jones*, Applicant's claimed color bars do not convey intelligence to a reader in the form of words or other symbols nor in the form of rulings as on a business form. Also, like *Jones*, Applicant's claimed color bars are structure, even though they might be produced by some sort of printing technique.

b. **In re Miller:** As stated in *In re Miller*, new and unobvious functional relationships define patentable subject matter:

Here there is a new and unobvious functional relationship between a measuring *receptacle*, volumetric *indicia* thereon indicating volume in a

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<sup>7</sup> Two of the three cited cases resulted in a reversal of the § 101 rejection. However, all of the cases analyze key issues for deciding whether presented claims are statutory.

certain ratio to actual volume, and a *legend* indicating the ratio, and in our judgment the appealed claims properly define this relationship. *In re Miller*, 164 USPQ 46 at 49 (underlining added for emphasis)

Applicant's claimed color bars define a new and unobvious functional relationship between color bars pre-printed on one region of proofing paper in relation to another region of the proofing paper. For the claimed article of manufacture to serve the function of being used in a proofing process, the claimed color bars must be located in the specified region of the sheet of paper. Applicant is not claiming any article of manufacture having color bars thereon.

There are no principles in *Miller* that can support the § 101 rejection. In fact, no § 101 rejection was even given in *Miller*.

**c. Ex parte Gwinn:**

*Gwinn* claimed a set of dice for use in a "parlor golf game." Each die represented a type of stroke (tee, fairway, putt) and had suitable marked faces for the number of strokes to be determined in accordance with the rules of the game. The claims were found to be unpatentable over prior art dice. However, *Gwinn* is clearly distinguishable from the presently claimed invention because in *Gwinn*, the dots on the dice are "symbols intended to convey intelligence" (see quotation from *In re Jones* above), whereas Applicant's claimed color bars are "structure" analogous to the pattern areas in *Jones*. While the claimed color bars are printed on the sheet of paper, they are not "printed matter" in that they are not meant to be read like one would read the face of a die to extract a meaning (here, the number of strokes).

There are no principles in *Gwinn* that can support the § 101 rejection.

While the Examiner has highlighted MPEP 706.03(a), there is simply nothing in this section or any of its cited cases to support a § 101 rejection of the pending claims. Stated simply, none of the cited cases present any fact pattern or holding that is applicable to Applicant's claimed invention or that supports a conclusion that the claims recite a "a mere arrangement of printed matter."

6. In the outstanding Office Action, the Examiner provides a rationale for the § 101 rejection that is based on two main arguments. The first argument is as follows:

Claims 1 and 12 are directed to a sheet of paper with printed color data which are per se not statutory. Data that is pre-printed in certain regions of a page is merely text or image data on a substrate, and the combination does not impart functionality. The printed matter (color bar) in no way depends on the paper, and the paper does not depend on the printed matter.

This argument is clearly erroneous. A substrate having data printed thereon is not, per se, non-statutory. The case law above clearly shows that it depends upon what type of data is printed on the substrate. A substrate having data such as printed lines, characters, words, and digits would likely be non-statutory based on prior case law. However, substrates having data such as pattern areas or other types of printing that do not convey intelligence to a reader in the form of words or other symbols is likely to be statutory based on prior case law. Applicant's claims clearly fall into the latter category and are thus statutory.

The Examiner's second argument cites *In re Gulack* for a holding that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability and reasons that Chalmers discloses the claimed invention, "except for the specific arrangement...and/or content of indicia (printed matter) set forth in the claims." The Examiner then concludes that since there is no novel and unobvious functional relationship between the printed matter (e.g., color bars) and the substrate (e.g., sheet of paper) which is required for patentability, then no patentable weight needs to be given to the content of the printed matter.

Applicant's claimed color bars define a new and unobvious functional relationship between color bars pre-printed on one region of proofing paper in relation to another region of the proofing paper. For the claimed article of manufacture to serve the function of being used in a proofing process, the claimed color bars must be located in the specified region of the sheet of paper. Applicant is not merely claiming any article of manufacture having color bars thereon. The prior art applied against the claims, namely, the test sheet in Chalmers, cannot serve the



function of being used in a proofing process, because its color bars are not in a marginal region and because it has no blank region as defined in the claims.

Since there is a novel and unobvious functional relationship between the printed matter (color bars) and the substrate (sheet of paper) which is required for patentability, then the Examiner must give patentable weight to the content of the printed matter (color bars). As discussed above in the "Prior Art Rejection" section, when patentable weight is given to the color bars, Chalmers fails to disclose or suggest the claimed invention.

In sum, the Examiner's revised rationale for the § 101 rejection is clearly erroneous, and thus withdrawal of § 101 rejection is respectfully requested.

### Conclusion

Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. Withdrawal of the outstanding rejections and issuance of a Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

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May 26, 2009  
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piece”; and “iron, steel or any other magnetic material.”

### III. “OPTIONALLY”

An alternative format which requires some analysis before concluding whether or not the language is indefinite involves the use of the term “optionally.” In *Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) the language “containing A, B, and optionally C” was considered acceptable alternative language because there was no ambiguity as to which alternatives are covered by the claim. A similar holding was reached with regard to the term “optionally” in *Ex parte Wu*, 10 USPQ2d 2031 (Bd. Pat. App. & Inter. 1989). In the instance where the list of potential alternatives can vary and ambiguity arises, then it is proper to make a rejection under 35 U.S.C. 112, second paragraph, and explain why there is confusion.

#### \* 2173.05(i) Negative Limitations

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation “R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl” was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

A claim which recited the limitation “said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber” in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation “incapable of forming a dye with said oxidized developing agent” was definite because the boundaries of

the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

#### 2173.05(j) Old Combination [R-6]

##### A CLAIM SHOULD NOT BE REJECTED ON THE GROUND OF OLD COMBINATION

With the passage of the 1952 Patent Act, the courts and the Board have taken the view that a rejection based on the principle of old combination is NO LONGER VALID. Claims should be considered proper so long as they comply with the provisions of 35 U.S.C. 112, second paragraph.

A rejection on the basis of old combination was based on the principle applied in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 37 USPQ 1 (1938). The principle was that an inventor who made an improvement or contribution to but one element of a generally old combination, should not be able to obtain a patent on the entire combination including the new and improved element. A rejection required the citation of a single reference which broadly disclosed a combination of the claimed elements functionally cooperating in substantially the same manner to produce substantially the same results as that of the claimed combination. The case of *In re*

1. An eye test chart apparatus comprising visual targets for multiple test purposes and a fixed target centrally positioned relative to the positions of said visual targets, wherein said visual targets are composed of patterns of combinations of at least two or more kinds of colors and predetermined shapes, and are arranged at predetermined positions on an image area corresponding to visual field regions to be examined, and wherein said fixed target is visually distinguishable from said visual targets, whereby color vision defects and their abnormal regions can be identified as a result of subject's visual identification of the visual targets arranged at the predetermined positions.